

REMARKS

Claims 1-42 are currently pending in the application. By this amendment, claim 24 is amended to correct the spelling of "communication". No other amendments are made at this time, because Applicants believe that claims 1-42 contain allowable subject matter. Reconsideration and withdrawal of all pending objections and rejections in view of the following remarks is respectfully requested.

35 U.S.C. §103 Rejections

The Office Action rejects claims 1-42 under 35 U.S.C. §103 (a) over U.S. Patent No. to Chlan et al. ("CHLAN") in view of U.S. Patent Application Publication No. US 2002/0004733 A1 to Addante ("ADDANTE"). These rejections are respectfully traversed.

The Examiner's rejections are moot in view of Applicant's Declaration Under 37 C.F.R. § 1.131.

With regard to this Declaration, Applicants note the Declaration has been signed by nine of the ten inventors. However, efforts by the undersigned to contact Mr. Gary Bob Kip Hansen to forward a copy of the Declaration were unsuccessful. The undersigned has been informed that Mr. Hansen has retired from the employ of the assignee and he is currently outside of the United States.

In any event, Applicants submit that even in the absence of Mr. Hansen's signature, the Declaration is sufficient to overcome the instant rejection. If the Declaration is not believed sufficient, by virtue of lacking Mr. Hansen's signature, a notification from the Examiner is requested, so further efforts can be made to locate Mr. Hansen, and forward the declaration for his signature.

Under 1.131, a rejection under 35 U.S.C. 103(a) based on a foreign patent or publication may, upon a proper showing, be overcome by removing the foreign patent or publication as a reference against the claims. Applicants submit that the Rule 131 Declaration submitted herewith is sufficient to remove the ADDANTE patent as a reference and thus is sufficient to overcome the above-noted rejections.

More specifically, Applicants submit that the Rule 131 Declaration is formally and substantively sufficient to establish that the Inventors had completed the invention defined

in at least claims 1-42 before the effective date of the ADDANTE reference, i.e., May 5, 2000. The statements in the Declarations show that the formal requirements of 131 are satisfied, namely:

- (1) the rejections to be overcome are under 103(a),
- (2) all the acts for completing the invention of independent claims 1, 17 and 32 (and those claims dependent thereon) were performed in this country, and/or in a NAFTA country, and/or WTO member country.
- (3) the effective date of the ADDANTE reference (May 5, 2000) is not more than one year prior to the filing date of the present application in this country.

It is respectfully submitted that the statements in the Declaration are also sufficient to satisfy the substantive requirements of 37 C.F.R. 131. The Declaration sets forth specific facts, of sufficient character and weight, to establish a **date of conception** before the May 5, 2000 effective date of the ADDANTE reference, and to show that the Inventors and their attorneys work to complete the present invention from a time before the effective date of the ADDANTE reference to a constructive reduction to practice, i.e., to the filing date of the application.

DATE OF CONCEPTION

As stated in the Declaration, a system for obtaining enriched activity data in a client-server communications network such that the information requested by a network element is cached at one or more other network elements, along with a computer readable medium containing a computer program for obtaining enriched activity data in a client-server communications network wherein information requested by a network element is cached at one or more other network elements, as defined in independent claims 1, 17 and 32 (and those claims dependent thereon) was conceived by the inventors before the effective date of the ADDANTE publication. An IBM Invention Disclosure and other supporting documents were submitted with the Declaration as supporting evidence of this prior date of conception. It is respectfully submitted that the Invention Disclosure shows that the Inventors had a definite and permanent idea of the complete and operative invention of

independent claims 1, 17 and 32 (and those claims dependent thereon), as presently pending, prior to the May 5, 2000 effective date of the ADDANTE publication. The supporting documents also show the prior date of conception.

In particular, the Invention Disclosure shows textually the features of independent claims 1, 17 and 32 (and those claims dependent thereon). The supporting documents also show that the features of independent claims 1, 17 and 32 (and those claims dependent thereon) were conceived prior to the effective date of the ADDANTE publication, May 5, 2000. Also, Applicants note that the original copy of the Invention Disclosure shows a date antedating the May 5, 2000 effective date of the ADDANTE publication. This and all other pertinent dates have been removed from the photocopies of the Invention Disclosure and accompanying documents submitted with the Declaration to prevent any potential prejudice to Applicants.

Applicants further submit that the Declaration filed herewith shows, unequivocally, that the Inventors had in their possession a definite and permanent idea of the complete and operative invention of independent claims 1, 17 and 32 (and those claims dependent thereon) before May 5, 2000 in a manner sufficient to satisfy the requirements of conception, as set forth in M.P.E.P. 715.07 and 2138.04, and thus constitute *prima facie* evidence of Applicants' date of conception of the invention in this country before the effective date of the ADDANTE publication.

DUE DILIGENCE

Applicants further submit that the Declaration shows the Inventors and their attorneys worked to complete the present invention from a time before the May 5, 2000 effective date of the ADDANTE publication. Inventor Nichols communicated with IBM patent counsel in preparing a patent application based on the Invention Disclosure prior to May 5, 2000.

As an example, IBM inventor Mr. Michael Nichols completed a Disclosure form (identified as RAL8-2000-0006) (attached hereto) of the present invention for IBM patent counsel prior to May 2000. Ms. Sandra Christopher of IBM communicated to Nichols prior to May 2000, confirmation in receiving the present invention disclosure (identified as

RAL8-2000-0006).

A patentability search was requested by IBM patent counsel and conducted by Wiens Search Service, Inc. prior to May 5, 2000.

As an example, IBM patent attorney Stephen Tryran communicated with outside patent counsel Mr. John J. Timar of Womble Carlyle Sandridge & Rice to prepare the application, and the IBM Invention Disclosure and documents were forwarded to counsel prior to May 5, 2000. The final draft of the patent application was forward to IBM on July 27, 2000.

The final draft of the patent application was filed in unexecuted form in the U.S. Patent and Trademark Office on August 18, 2000. The declaration was executed by the inventors between September 13, 2000 to October 2, 2000. The executed declaration was submitted on October 27, 2000.

Under M.P.E.P. 2138.06, only **reasonable** diligence is required in this regard. More specifically, 2138.06 states that a patent attorney will be held to have exercised reasonable diligence if the attorney worked reasonably hard on the application during the critical period, taking into consideration any backlog of unrelated cases the attorney may have had and his completion of those cases along with the present application in chronological order.

Applicants submit that the Declaration submitted herewith is sufficient to show that the Inventors had completed their invention prior to May 5, 2000.

Thus, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of the claims 1-42.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to IBM Deposit Account No. 09-0547 (Endicott).

Respectfully submitted,

Paul Roger BRISCOE, *et al.*

A handwritten signature in black ink, appearing to read 'A. Calderon', with a stylized flourish at the end.

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